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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,537	11/19/2001	Bradley A. Myers	26495-4	4428
21130	7590	12/20/2005	EXAMINER	
BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114			GRAYSAY, TAMARA L	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 12/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/992,537	Applicant(s) MYERS	
	Examiner Tamara L. Graysay	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(1 page)</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-10 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (US-5862223).

- a. Regarding claim 1, Walker teaches a method for managing an investigation case (solution sought by end user) comprising: (a) receiving a case from a client (the controller receives an expert request or solution sought by an end user, see abstract for example); (b) assigning an investigator to the case (search program identifies qualified expert, see abstract for example); and (c) managing the case on behalf of the client and the investigator by a case manager (the central controller transmits user requests and expert answers, see abstract for example).

- b. Regarding claims 2, Walker teaches the receiving step comprising: (a)^(a) accessing a case entry form via the case manager Web site; (b)^(a) entering certain case information in to the case entry form; and (c)^(a) submitting the case via the case manager Web site (18:45-46, end users may fill out an electronic form built into the web page of the central controller).

- c. Regarding claim 3, Walker teaches the end user entering the case information (18:45-46, end users may fill out an electronic form built into the web page of the central controller).
- d. Regarding claim 4, Walker teaches the case manager entering the case information (18:37-38, end user requests submitted in audio format may be transcribed into digital text at the controller).
- e. Regarding claim 5, Walker teaches entering investigator selection (17:13-19, the end user attaches criteria including qualifications of the expert, for example).
- f. Regarding claim 6, Walker teaches assigning the investigator from a network (expert database 255, for example).
- g. Regarding claim 7, Walker teaches assigning from a preferred investigator list insofar as Walker includes different levels of expertise for the expert (for example, 17:25 and 39-42; 18:13-16, hierarchy of experts) and the user includes subject area and level of expertise in the criteria (17:24-26).
- h. Regarding claim 8, Walker teaches assigning the expert via a computer or automatically, as broadly recited.
- i. Regarding claim 9, Walker teaches use of manually assigning the investigator insofar as an approval committee (human intervention as a form of manual assignment) may be used to verify the expert qualifications (see 18:6-13).
- j. Regarding claim 10, Walker teaches the assigning step comprising: (a)^(b) identifying a qualified investigator from an investigator network based on at least one parameter (17:13-19, the end user attaches criteria including qualifications of the expert,

for example; and 17:36, the controller searches expert database 255 for matches of the criteria with expert qualifications); (b)^(b) calculating a budget for the case (17:17, price); and (c)^(b) sending notification to the investigator requesting acceptance of the assignment to the case (17:48-52 and 57, Exchange sends a message to the expert asking if willing to bid on the assignment).

k. Regarding claim 14, Walker teaches the managing step comprising: (a)^(c) entering time and expense entries by the investigator; and (b)^(c) reviewing time and expense entries entered by the investigator (16:36-37, audit database 480 is used for payment records; and beginning at 21:63, Billing Embodiment).

l. Regarding claim 15, Walker teaches the managing step comprising: (a)^(c) generating standardized reports and invoices (claims 50, 51, 110, 111 recite invoice billing).

m. Regarding claim 16, Walker teaches further comprising the steps of: (d) providing a client enrollment form via the case manager Web sit to allow client applicants to enroll as clients (18:45-46, end users may fill out an electronic form built into the web page of the central controller); and (e) providing an investigator enrollment form via the case manager Web site to allow investigator applicants to enroll as investigators (8:16-31, the candidate experts submit detailed applications to the Exchange for review and acceptance).

n. Regarding claim 17, Walker includes an expert database 255 that maintains pertinent data. The zip code and geographic region are a type of data, i.e., nonfunctional

descriptive material. The nonfunctional data has not been given patentable weight because how the data is organized is not part of the process in any manipulative sense.

o. Regarding claim 18, Walker teaches a method for managing a service procedure (solution request from end user) comprising: (a) receiving a request for a service procedure from a customer (the controller receives an expert request or solution sought by an end user, see abstract for example); (b) assigning a subcontractor to the service procedure (search program identifies qualified expert, see abstract for example); and (c) managing the service procedure on behalf of the customer and the subcontractor by a manager (the central controller transmits user requests and expert answers, see abstract for example).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US-5862223).

a. Regarding claim 11, Walker teaches the sending step comprising: notification as an email message having a hyperlink associated with the case manager Web site (14:26, the expert provides an email address; and, 15:21-42, the network interface 245 is a gateway to communicate with experts using electronic mail designed to link people and information over the Internet, wherein messages can include enclosures such as files and graphics). The notification system is capable of sending a hyperlink insofar as it can send files and graphics in the messages.

b. Regarding claim 12, Walker teaches identifying the investigator (expert) based on criteria provided by the client (end user criteria 117). The criteria include subject area, or a topic area, and other qualifications of the expert. Thus the reference is capable of including any criteria set by an end user. An end user that requires an expert from a particular jurisdiction would have included the geographic information, such as zip code, to ensure that the expert is from the particular jurisdiction.

c. Regarding claim 13, Walker teaches the qualified expert having a valid license (15:1) as well as other industry qualifications (15:1). The examiner takes Official notice

Art Unit: 3623

that certain areas of expertise, like medicine and construction, require insurance or bonding in order to legally perform work or give advice. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Walker to include a qualified investigator (expert) having a valid insurance policy.

Art Unit: 3623


Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 12/12/05
Tamara L. Graysay
Examiner
Art Unit 3623

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